

REMARKS

Claims 1-45 and 47-54 are presented for reconsideration without amendment in light of the following remarks and authorities. Claim 46 and any dependent claims have been amended to overcome a minor informality without narrowing the claims. Such amendment to claims is only for the purpose of expediting the prosecution of this application and is not to be construed as an abandonment of any of the novel concepts disclosed therein.

1. The requirement for restriction is again respectfully traversed at least for the reasons set forth in the response filed April 1, 2003.

In the Office Action dated April 23, 2003, the Examiner did not deal with the reasoning and authorities set forth on pages 1 and 2 of the response which require that the Examiner make a showing that the inventions be independent and distinct. We said, "Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." The Examiner is again respectfully requested to comply with this request should the requirement for restriction be again maintained.

2, 3. Claims 46 and 48 as originally presented stood rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Regarding claim 46, there is said to be no antecedent basis for "said first shielding device." We have amended this claim without narrowing it by deleting "first." Accordingly, withdrawal of this ground of rejecting claim 46 is respectfully requested.

Regarding claim 48, it is said that Applicant should clarify the structure/arrangement of the second shielding device. This ground of rejection is respectfully traversed. Claim 48 positively recites that the second shielding device is positioned so that the second shielding device second surface faces the second core portion. Accordingly, withdrawal of this ground of rejection of claim 48 is respectfully requested.

4, 5. Claim 38 stands rejected under 35 U.S.C. §102(b) as being anticipated by Takai. The reference is said to disclose a shielding device 17 for an electrical transformer having first

and second core portions 16, first and second coils disposed on said first and second portions, respectively.

This ground of rejection is respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force

the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

Claim 38 positively recites that said shielding device is constructed and arranged to electrically shield the first core portion from the second core portion. The reference discloses, "A shield body 17 is fixed by putting the notched section 18 of the body 17 in the spool section 12 of bobbin 11. When the shield body 17 is fixed, the section 12 is divided into a primary and secondary winding areas" The reference discloses that shield 17 separates a primary winding area of spool section 12 of bobbin 11 from a secondary winding area of spool section 12 of bobbin 11. There is no disclosure that the shield is constructed and arranged to electrically shield a first core portion from a second core portion as called for by claim 38. The figure clearly discloses that shield 17 of the reference does not shield one portion of core 16 from another core portion. Accordingly, withdrawal of the rejection of claim 38 as anticipated by Takai is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each element in claim 38.

6. Claims 38, 39, 41 and 46-48 stand rejected under 35 U.S.C. §102(b) as anticipated by Maehara. This reference is said to disclose a shielding device 37 for a transformer having first and second core portions 32, first and second coils 31, 33, disposed on the first and second core portions, respectively, the shielding device comprising an insulating layer 54 and at least one conductive layer 52, 53 disposed on the insulating layer. This ground of rejection is respectfully traversed.

This reference states at column 3, beginning at line 41, "A shield member 37 is arranged at a position near to the primary winding 31 between the same primary winding 31 and the secondary winding 33 and the heater winding 36 of the boosting transformer 30. This shield member 37 is connected to a core 32 which in turn is connected substantially to a housing 6 of the high frequency heating apparatus." This reference further recites at column 4, line 18, "The shield member 37 is indispensably interposed between the primary winding 31 and the secondary winding 33 as shown" This reference discloses shield member 37 separating the primary winding from the secondary winding. This reference fails to disclose that the shield separates one core section from another core section as called for by the rejected claims. FIGS. 2 and 3 of the reference clearly show that shield 37 does not separate one core portion from another core portion. Accordingly, withdrawal of the rejection of claims 38, 39, 41 and 46-48 as anticipated by this reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim language from the reference regarded as corresponding to each element in each of these rejected claims.

7, 8. Claims 38-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Maehara or Takai as a primary reference in view of Fischer as a secondary reference. Either primary reference is said to disclose the instant claimed invention except for the specific structure/material for the shielding device. The secondary reference is said to disclose a shielding device with specific reference to FIG. 3 comprising an insulating layer, at least one conductive layer 54, 80, 82 disposed on the insulating layer and an electrical drain wire 90 connected to the conductive layer. It is said it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a drain wire connected to the shielding device of either primary reference as said to be suggested by the secondary reference for the purpose of providing better shielding for the device. It is said the specific material used for the conductive layer/shielding device would have been an obvious design consideration based on the intended application used and the environment. This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

We have shown above that neither primary reference discloses each and every element in the claims arranged as in the rejected claims. It is therefore impossible to combine the references to meet the terms of the rejected claims.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

The inability to combine the references to meet the terms of the rejected claims is reason enough for withdrawing the rejection of claims on the combination of references.

As to the allegation of "obvious design consideration," that is a conclusion, not a reason.

In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

Accordingly, withdrawal of the rejection of claims based on the combination of the primary references with the secondary reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in each reference regarded as corresponding to an element in a rejected claim and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of rejected claims.

In view of the foregoing amendment, authorities, remarks and the inability of the prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, claims 38-48 are submitted to be in a condition for allowance, and notice thereof is respectfully requested. In the absence of pertinent prior art, claims 1-37 and 49-54 are also submitted to be in a condition for allowance, and notice thereof is respectfully requested.

Should the Examiner regard the application as not in a condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

Applicant : Wenjian Gu et al.
Serial No. : 09/928,775
Filed : August 13, 2001
Page : 18 of 18

Attorney's Docket No.: 02103-415001 / AABOSS39

We enclose a check in the amount of \$950.00, together with the Petition for Three-Month Extension of Time. The Commissioner is authorized to apply any other charges to deposit account 06-1050, Order No. 02103-415001.

Respectfully submitted,

FISH & RICHARDSON P.C.

Date: OCT 23 2003


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